

REMARKS

This is in response to the Office Action mailed on November 21, 2005, and the references cited therewith.

Claims 27 and 34 are amended. Claim 42 has been added. Claims 1-15, 17-23, 25-31, 33-34 and 37-42 are now pending in this application.

§101 Rejection of the Claims

Claims 27-31 and 33-34 were rejected under 35 USC § 101 because the claimed invention is directed to non-statutory subject matter. The claims have been amended as suggested, and are not believed to narrow any particular element of the claim.

§103 Rejection of the Claims

Claim 1 was rejected under 35 USC § 103(a) as being unpatentable over Coberfin et al. (U.S. Patent No. 6,269,243) in view of Koga (Patent No. JP41106448A – Document Identifier: JP 11064484 A). This rejection is respectfully traversed, as a proper *prima facie* case of obviousness has not been established. Coberfin et al, does not describe one of the elements it is cited for, and the combination is believed improper at least because the suggestion to combine them is not based on solving the same or similar problem as the presently claimed invention.

The Office Action indicates that Coberfin et al., has “a controller (e.g., means of authority 5, column 4, line 30) that controls RF emissions of the separate wireless phone, to maintain the RF emissions below a predetermined level (e.g., interference level, column 4, lines 17-36).” As applicant reads the cited text, the mobile telephone contains a power auto-matching system that appears to cause the mobile telephone to operate at a matched level of power to the radiocommunication means R. The power level of the radiocommunication means R is “lowered in such a way as not to allow such interference.” Col. 4, lines 49-50. The method described in Coberfin et al., is quite different than that claimed, and does not describe controlling RF emissions of a wireless phone to maintain the RF emissions below a predetermined level. It merely uses an admittedly well known power auto-matching system to keep the operating power low. It does not directly control emissions to be below a desired level as claimed. Thus, the

reference does not teach or describe the cited elements of claim 1, and the rejection should be withdrawn.

The Office Action indicates that Coberfin et al., does not clearly teach an RF detector that detects RF emissions of the separate wireless phone, or a controller coupled to the RF detector to maintain the RF emissions below a predetermined level. Koga is cited as providing such elements. The reason provided in the Office Action for combining Coberfin et al., and Koga is stated as: "It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of Koga to the teaching of Coberfin et al. in order to prevent abnormal vibration caused by the radio wave emitted from the emission antenna (see abstract)." The reason is taken from Koga, and appears to have nothing to do with the problem addressed by claim 1, which is similar to that of Coberfin et al. Thus, the combination is believed improper.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the

prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Applicant respectfully submits that the Office Action did not make out a *prima facie* case of obviousness for at least the following reasons:

(1) The suggestion is not related to the same or similar problem.

The suggestion recited in the Office Action does not recite the same or similar problem which the claimed invention addresses. The suggestion provided in the Office Action refers to preventing abnormal vibration. The present claimed invention is not directed to preventing abnormal vibration. Coberfin et al., is also not describe a problem associated with abnormal vibration. Thus, the suggestion to combine is not proper, and the rejection should be withdrawn.

(2) No reasonable expectation of success in making the combination.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Coberfin et al., uses power auto-matching to remove danger of interference with electronic systems on board the aircraft. There is no indication of how the teaching of Koga can be combined with a system that already appears to operate in the desired manner to reduce interference with electronic systems on board an aircraft. How would two separate systems, both designed to control power levels, cooperate with each other? This appears to be a complex endeavor, and a reasonable expectation of success has not been shown in the prior art.

(3) Claimed features lacking in combination.

The references must teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). In contrast, as described above, Coberfin et al., does not directly control emissions to be below a desired level as claimed. Thus, at least one element is lacking in the combination, if proper, and the rejection should be withdrawn.

(4) The cited references teach away from applicant's claimed invention.

A factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams*, 383 U.S. 39, 52, 148 USPQ 479, 484 (1966); *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969); *In re Caldwell*, 319 F.2d 254, 256, 138 USPQ 243, 245 (C.C.P.A. 1963). Coberfin et al., uses power auto-matching to remove danger of interference with electronic systems on board the aircraft. One would be discouraged from seeking further control, absent some expressed need, and thus, would not be inclined to consider any form of measuring the emissions as claimed. No such need has been identified in the art.

Any of the above reasons should be sufficient to withdraw the rejection.

Claim 42 has been added and recites a wireless device. It is believed to distinguish the reference for at least the same reasons as claim 1.

Allowable Subject Matter

Claims 27-31 and 33-34 were rejected under 35 USC § 101, but allowable if rewritten to cover come the 35 USC § 101 rejection. They were so rewritten.

Claims 8, 12, 18, 26 and 41 were allowed previously with the reason set forth in the previous Office Action dated 03/08/2005.

Claim 13 was previously amended to include the allowable subject matter of claim 16. Therefore, claim 13 was allowable with the same reason set forth in the previous Office Action dated 03/08/2005.

Claims 19 was previously amended to included the allowable subject matter of claim 24. Therefore, claim 19 was allowable with the same reason set forth in the previous Office Action dated 03/08/2005.

Claim 37 was previously amended to include the allowable subject matter of claim 39. Therefore, claim 37 is now allowable with the same reason set forth in the previous Office Action dated 03/08/2005.

Claims 2-7 and 9-11 depend on claim 8. Therefore, they are allowable.

Claims 14-15 and 17 depend on claim 13. Therefore, they are allowable.

Claims 20-23 and 25 depend on claim 19. Therefore, they are allowable.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6972 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of February, 2006.

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